

## **Remarks**

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

### ***Allowable Subject Matter***

Applicants note with appreciation the indication that claim 24 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

It is noted, however, that the Office Action identifies claim 24 as being both allowable and anticipated by *Glossop*. Applicants believe the indication of claim 24 as being anticipated is in error, and presume claim 24 would be allowed if rewritten in independent form.

### ***Complete Examination of the Claims***

Claim 13 is indicated as being rejected in the Office Action Summary, but the Examiner does not indicate which, if any, references anticipate or render obvious claim 13. Accordingly, Applicants respectfully request that should a subsequent Office Action be issued, such Action correctly indicate whether or not claim 13 is rejected, and if so, the art that allegedly anticipates or renders obvious claim 13. Further, and in view of the above, since a complete examination of all claims has not been provided in the present Office Action, it is respectfully submitted that any subsequent Office Action should not be made final.

### ***Claim Amendments***

Independent claims 1 and 22 have been amended herein to further clarify the invention. Claim 13 has been amended to place it in independent form. As noted above, claim 13 was not examined in the preset Office Action. Since claim 1 (which claim 13 depends from) has been amended herein, claim 13 has been amended to

independent form so as to preserve the features that were not examined in the previous Office Action.

***Claim Rejections - 35 USC § 102 and § 103***

Claims 1-3, 6-12, 14, 15 and 22-25 as previously presented were rejected as being anticipated by or unpatentable over *Glossop* (US 6,203,543), *Bramlet et al.* (US 6,183,474) and/or *Neubauer et al.* (US 6,719,757). Withdrawal of the art rejections is respectfully requested for at least the following reasons.

Independent claims 1 and 22 have been amended herein. Claim 1 now recites a fixing device for mounting to a bone, said fixing device comprising an operative section including at least one guide for at least one securing element, wherein said guide opens axially toward an outer end of the operative section to allow axial insertion of the securing element into the guide, and a centerline of said guide is offset from a centerline of said operative section, whereby the securing element can be inserted into and moved axially along the guide into cooperative engagement with the bone and the operative section to preclude rotation of the operative section. Claim 22 now recites a fixing system for attaching a further device to a bone, comprising an axially extending groove formed in the operative section, said groove extending parallel to an axis of the operative section, wherein a centerline of the groove is offset from a centerline of the operative section.

***Glossop***

In rejecting the claims based on *Glossop*, the Examiner identifies Fig.1 and Fig. 2D as teaching the claimed invention. Referring initially to Fig. 1, there is shown a device for securing objects to a bone that includes a threaded bone screw 12 coupled to a sleeve 14. Although not clear, Applicants believe the Examiner is equating a lower portion of the bone screw 12 and a lower portion of the sleeve 14 as the operative section of claim 1, and an upper portion 24 of the bone screw 12 (and possibly the head 18) as the securing element of claim 1. The Examiner does not indicate which portion

of Fig. 1 is equated to the guide of claim 1. Applicant presumes the Examiner equates the threaded bore within the sleeve 14 as the guide of claim 1.

As can be seen in Fig. 1, a centerline of the bone screw 12 and sleeve 14 (the presumed operative section), and a center line of the threaded bore within the sleeve 14 (the presumed guide) are the same. Thus, Fig. 1 of *Glossop* does not teach or suggest that the alleged guide includes a centerline that is offset from a centerline of the alleged operative section. Similar arguments apply to claim 22.

The remaining claims directly or indirectly depend from claim 1 or 22 and, therefore, can be distinguished from Fig.1 of *Glossop* for at least the same reasons.

With respect to Fig. 2D of *Glossop*, the Examiner identifies the lower portion of the bone screw 12 and the sleeve 14 as the operative section, an upper portion 24 of the bone screw 12 as the securing element, and slots within a clamp 20 as the guide.

With respect to the alleged guide (i.e., the clamp 20), the clamp 20 interfaces with an outer portion of the sleeve 14, and not the upper portion 24 of the bone screw 12 (i.e., the alleged securing element). Thus, this interpretation does not teach *at least one guide for at least one securing element*, as recited in claim 1. Further, the alleged securing element (i.e., the upper portion 24 of the bone screw 12) and the alleged operative section (i.e., the lower portion of the bone screw 12 and the sleeve 14) include a common component (i.e., the bone screw 12). The whereby clause of claim 1 clearly defines the operative section and the securing element to be different components.

Accordingly, Fig. 2D of *Glossop* also does not teach or suggest all the features of amended claim 1.

Claim 22 recites a removable securing element for insertion into the groove, wherein when at least a portion of the securing element is in the groove, the securing element extends outwardly from the operative section and *interacts with the bone* to fixedly retain the securing element in the bone.

As can be seen in Fig. 2D, the alleged securing element (i.e., the upper portion 24 of the bone screw 12) does not interact with the bone. Accordingly, Fig. 2D of *Glossop* also does not teach or suggest all the features of amended claim 22.

The remaining claims directly or indirectly depend from claim 1 or 22 and, therefore, can be distinguished from Fig. 2D of *Glossop* for at least the same reasons.

Accordingly, withdrawal of the rejections based on *Glossop* is respectfully requested.

### ***Bramlet***

*Bramlet* discloses a surgical fastener that includes an elongated anchor 22 for insertion into a bone, wherein the anchor includes an insert 44 and a series of pins 60. A fastener 24 is inserted into the anchor 22 (the alleged operative section), wherein a rotation of the fastener 24 relative to the insert 44 causes the pins 60 to extend, thereby securing the anchor in the bone.

The Examiner contends that *Bramlet* discloses an operative section (the anchor 22) having external threads, and an *axially extending groove* comprising the exit slit of a removable securing element 60. Referring to Fig. 2 of *Bramlet*, the exit slit identified by the Examiner is formed as an arc and exits a side wall of the anchor. Thus, the exit slit does not *open axially toward an outer end of the operative section*, as recited in amended claim 1, nor does the exit slit comprise a *groove extending parallel to an axis of the operative section*, as recited in amended claim 22.

Further, to the extent the Examiner may argue that the fastener 24, the elongated insert 44 (referred to as the anchor 22 by the Examiner) and "flat" 54 read on the invention of claim 1 or 22, it is noted that a centerline of the flat 54, the fastener 24 and the insert 44 are substantially the same (not offset as recited in claims 1 and 22). Thus, the invention of claims 1 and 22 can be distinguished over this interpretation of *Bramlet*.

The remaining claims directly or indirectly depend from claim 1 or 22 and, therefore, can be distinguished from *Bramlet* for at least the same reasons.

Accordingly, withdrawal of the rejections based on *Bramlet* is respectfully requested.

***Neubauer in view of Glossop***

In accordance with 35 U.S.C. § 103(c), withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested. *Neubauer* only qualifies as prior art under 35 U.S.C. § 102(e). In addition, *Neubauer* was developed by "another person" since the present invention was developed by Stefan Vilsmeier, Rainer Birkenbach, and Eric Merlin, while *Neubauer* was developed by Timo Neubauer and Matthias Brundobler. Also, at the time the present invention was made, both *Neubauer* and the present invention were owned or subject to an obligation of an assignment to the same entity, namely BrainLab AG.

In view of the above, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) based on *Neubauer* and *Glossop* is requested.

**Conclusion**

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

By   
Kenneth W. Fafrak, Reg. No. 50,689

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113

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Christine Arndt

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